

REMARKS

By this amendment, Applicants amend claims 38, 48, 58, and 68-70. Claims 38-41, 44-51, 54-61, and 64-70 remain pending.

In the November 16, 2007 Final Office Action¹, the Examiner rejected claims 38-41, 44-46, 48-51, 54-56, 58-61, 64-66, and 68-70 under 35 U.S.C § 102(b) as being anticipated by U.S. Patent 6,347,333 to Eisendrath et al. ("*Eisendrath*"); and rejected claims 47, 57, and 67 under 35 U.S.C § 103(a) as being unpatentable over *Eisendrath* in view of U.S. Published Patent Application No. 2002/0032790 to Linderman ("*Linderman*"). Applicants respectfully traverse each of these rejections.

I. Rejection under 35 U.S.C. § 102(b)

Applicants respectfully traverse the rejection of claims 38-41, 44-46, 48-51, 54-56, 58-61, 64-66, and 68-70 under 35 U.S.C § 102(b) as being anticipated by *Eisendrath*. In order to properly establish anticipation under 35 U.S.C. § 102, "each and every element as set forth in the claim [must be] found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913,

¹ As Applicants' remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicants' silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicants that such assertions are accurate or such requirements have been met, and Applicants reserve the right to analyze and dispute such in the future.

1920 (Fed. Cir. 1989). See also M.P.E.P. § 2131. Here, *Eisendrath* does not disclose each and every element of the pending claims.

Independent claim 38 recites “[a] method for providing access to an electronic course that is hosted by an external system,” including, among other things “transmitting, by the server, a track command to the external system for tracking the user activity through the at least one selected course.”

On page 3 of the Final Office Action, the Examiner appears to allege that *Eisendrath* discloses the claimed “server” as co-host server 204 from Figure 2, and the claimed “external system” as host system 250. However, even assuming that the Examiner’s allegations are covered, which Applicants do not concede, *Eisendrath* is silent with respect to “transmitting, by the server, a track command to the external system for tracking the user activity through the at least one selected course,” as recited in claim 38 (emphasis added). Instead, the Examiner alleges that the claimed “track command . . . for tracking the user activity” is disclosed by *Eisendrath*’s purported ability for a user to retrieve his/her progress in the course modules. *Eisendrath*, col. 8, lines 32-52. To the extent that the Examiner’s allegations can be considered correct, a student’s request for his/her progress from *Eisendrath* is not sent from co-host server 204 (alleged “server”) to host system 250 (alleged “external system”), but is instead sent from an individual student to host system 250. Therefore, *Eisendrath* cannot teach “transmitting, by the server, a track command to the external system for tracking the user activity through the at least one selected course,” as recited in claim 38 (emphasis added). Accordingly, *Eisendrath* fails to disclose each and every element of claim 38, and the Examiner should withdraw the rejection of this claim under 35 U.S.C. § 102(b).

Independent claims 48, 58, and 68-70, while of different scope than independent claim 38, comprise similar recitations as claim 38. Accordingly, the Examiner should withdraw the rejections of claims 48, 58, and 68-70 for at least the reasons discussed previously.

Claims 39-41, 44-46, 49-51, 54-56, 59-61, and 64-66 depend from one of claims 38, 48, and 58. Accordingly, the Examiner should withdraw the rejection of claims 39-41, 44-46, 49-51, 54-56, 59-61, and 64-66 at least due to their dependence.

II. Rejection under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 47, 57, and 67 under 35 U.S.C § 103(a) as being unpatentable over *Eisendrath* in view of *Linderman*. No *prima facie* case of obviousness has been established.

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. . . . [R]ejections on obviousness cannot be sustained with mere conclusory statements.” M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007) (internal citation and inner quotation omitted). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art.” M.P.E.P. § 2143.01(III) (emphasis in original). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03. “In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves

would have been obvious, but whether the claimed invention as a whole would have been obvious. M.P.E.P. § 2141.02(I) (emphases in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966). . . . The factual inquiries . . . [include] [a]scertaining the differences between the claimed invention and the prior art.” M.P.E.P. § 2141(II). “Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” M.P.E.P. § 2141(III).

Here, a *prima facie* case of obviousness has not been established because the scope and content of the prior art has not been properly determined nor have the differences between the claimed invention and the prior art been properly ascertained. Accordingly, no reason has been clearly articulated as to why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art.

Claims 47, 57, and 67 depend from claims 38, 48, and 58, respectively, and therefore, include all recitations therein. As discussed previously *Eisendrath* fails to teach or suggest each and every element of claims 47, 57, and 67.

Linderman fails to cure the deficiencies of *Eisendrath*. That is, *Linderman* fails to teach or suggest “transmitting, by the server, a track command to the external system for tracking the user activity through the at least one selected course,” as recited in claim 38. Accordingly, *Eisendrath* and *Linderman* fail to disclose each and every element of claims 47, 57, and 67.

In view of the failure of the prior art to teach or suggest a combination including the elements of claims 47, 57, and 67 discussed above, the Office Action has failed to

properly determine the scope and content of the prior art and to properly ascertain the differences between the prior art and the claimed invention. Thus, the Office Action has failed to clearly articulate a reason why the claims would have been obvious to one of ordinary skill, in view of the prior art. Accordingly, no *prima facie* case of obviousness has been established, and the Examiner should withdraw the rejection of claims 47, 57, and 67 under 35 U.S.C. § 103(a).

CONCLUSION

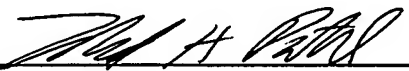
In view of the foregoing, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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